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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/217,469 12/21/98 ZAYDMAN

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EXAMINER

QM01/0420

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HOANG, T

ART UNIT

PAPER NUMBER

3742  
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/217,469

Applicant(s)

ZAYDMAN, MIKHAIL

Examiner

Tu Hoang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/13/00, 1/22/01, 3/16/01.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 26-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 1998 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

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### ***Reissue Applications***

For clarification purpose, all previous amendment dated April 10, 2000 (paper number 10) and amendment to both the specification and claims of the original patent filed on December 21, 1998 had been canceled as requested by the applicant. In lieu of the response filed on January 22, 2001 and substitute specification filed on March 19, 2001, the amendment filed on November 13, 2000 has been approved and entered. The substitute specification along with claims 1-14 and 26-34 in separate sheets received on March 19, 2001 has been approved and entered. Such claims 1-14 and 26-34 on separate sheets are entered and in placed of the claims 1-14 and 26-34 of the prior amendments (i.e., November 13, 2000 and others)

As such amendments have either been entered or canceled, there is no abstract provided replacing the original one.

### ***Drawings***

It is noted that the drawings filed December 21, 1998 (copies of the drawings from the printed patent) with the addition of new Figures 23-24 are approved by the examiner and acceptable for examination purposes. They will be used as the drawings for publication in the printed reissue patent if approved by the draftsman. Applicants' January 22, 2001 request to transfer drawings is noted. However, effective November 7, 2000 transfer of drawings from the original patent to the reissue application cannot be made.

It is noted since the amendment filed April 10, 2000 (which included the cancellation of Figures 23-24 and all prior amendments to the specification) had not been entered as for being improper and incomplete response. This amendment had been canceled in favor of the latter amendment filed on November 13, 2000, therefore, Figures 23 and 24 are still included in the reissue original filing and considered as amendments to the original patent drawings.

It is noted that such amendments to the original patent drawings are not permitted under 37 CFR 1.173(b)(3). If there are changes to be made to the patent drawings, must be made in a manner required by 37 CFR 1.84. and 37 CFR 1.173(b)(3).

The drawings filed on December 21, 1998 have been objected under 35 USC 251 because they introduce new matter since the original disclosure does not support the showing of the newly added Figures 23-24.

The drawings are also objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "tray means having a bottom portion sloped toward a door of said oven" as now recited in claim 4 and the "at least two rotatable discs, said discs being detachably connected to said grate and said rod" as recited in newly added claim 32 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

It is noted that Figures 18B and 18C while are showing a tray 12 with a bottom portion 13, the bottom portion 13 is not sloped but appeared to be horizontal to the oven floor. It appears that only the side wall portion of the tray is sloped.

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It is further noted that while Figures 12A and 13A are showing the grate connected to the discs and Figure 13B is showing the grate connected to the rod, there is no original disclosure or embodiment figure for disclosing/showing the grate connected to both the rod and the discs.

### **Specification**

Since all prior amendments had been canceled in favor of the amendment filed on November 13, 2000 and March 19, 2001, this application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

**New matter:** The specification is objected to under 35 U.S.C. 251 because the specification, as originally filed, does not provide support for the invention as now claimed in the amended claim 4, does not provide support for newly added Figures 23-24, and does not provide support for the invention as now claimed in claim 32. Applicant is required to cancel the new matter in the reply to this Office action.

**Claims Rejections under 35 USC § 251:** claim 4 as now amended and newly added claim 32 are rejected under 35 U.S.C 251 as being improperly introduced new matter in a reissue application.

### **Rejection based upon recapture of surrendered subject matter:**

Amended claims 1-14 and newly added claim 34 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F. 3d 1472, 46, USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F. 3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

It is noted that in the present reissue application, claims 1-14 was amended with the limitation of the original claim 19 (renumbered as claim 1) in combination with other limitations (as recited in the original patent application claims 6-7) now being omitted or broadened (i.e., "box-shaped"). Since at least such limitation now being omitted or broadened in the present reissue was originally presented in the original application to make the claims allowable over a rejection (i.e., the rejection of the original claim 1 over Jacobs) made in the original application, such omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

It is noted that in the patent application, original claims 1-3, 4, 5-6, 9, 12 and 17 were rejected by Jacobs (US 4,924,071). The claims then were amended with the cancellation of claims 1, 4, 7-13, and 17 and the addition of claims 18-26.

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Only claim 18 had been again rejected by Jacobs. Then, claim 18 had been canceled along with claim 22 and claim 27 had been added. Claim 6 had been canceled latter. Amendments have been made to claims 2, 3, 5, 14, 15, 16, 19, 20, 21, 23, 24, 25, 26, and 27 to put these claims under condition for allowance in which the original claim 19 included all limitations of the canceled original claim 1 in combination with the limitation of the original claim 2 and others and the allowable subject matter of the original claim 19 as a whole: "a compact smoking oven comprising at least one of the following structures: a box-shaped housing having a peripheral wall composed of two wall portions spaced from one another and including an inner wall portion provided with a plurality of throughgoing openings and an outer wall portion, and a container for accommodating wooden chips and having at least one wall provided with openings" as claimed in the original claims 19-21 and 23-27, and "food supporting means including at least one support provided with at least two rotatable discs having different axes of rotation and hooks" as claimed in the original claim 21.

Original claim 19 was renumbered as claim 1 when issued. The original patent claims 2, 3, and 5 were dependent from the original claim 19 and were renumbered as 2, 3, and 4 respectively for issue.

The original claim 20 included all limitations of the canceled original claim 1 in combination with the limitation of the canceled original claim 8 (i.e., "an openable door....to prevent smoke escape from said housing"). Original claim 20 was renumbered as claim 9 for issue.

The original claim 21 also included all limitations of the canceled original claim 1 in combination with the limitation substantially the same as recited in the canceled original claim 13 (i.e., "food product supporting means...and a plurality of hooks for suspending the food product"). Original claim 21 was renumbered as claim 10 for issue.

The original claim 23 included also all limitations of the canceled original claim 1 in combination with limitations recited in the canceled original claim 11 (i.e., "heating means...distributed fashion"). Original claim 23 was renumbered as claim 11 for issue.

The original claim 24 also included all limitations of the canceled original claim 1 in combination with limitations "food product supporting means including at least one rod rotatable about a horizontal axis and having a support displaceable in an axial direction for removal of the food product". Original claim 24 was renumbered as claim 12 for issue.

The original claim 25 also included all limitations of the canceled original claim 1 in combination with limitations recited in the original claim 13. Original claim 25 was renumbered as claim 5 for issue.

The original claims 14, 15, and 16 were dependent from claim 25 and were renumbered as claims 6, 7, and 8 respectively for issue.

The original claim 26 also included all limitations of the canceled original claim 1 in combination with limitations recited in the canceled original claim 17 (i.e., "food product supporting means including a grate...are moved") and a recitation of "two discs rotatable about a horizontal axis with one of said discs displaceable in an axial direction; and a turnable rod located between said rotatable discs and supporting said grate". Original claim 26 was renumbered as claim 13 for issue.

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The original claim 27 was replaced the canceled claim 22, claim 27 also included all limitations of the canceled original claim 1 in combination with limitations recited in the canceled original claim 10. Original claim 27 was renumbered as claim 14 for issue. It is further noted that the limitation of canceled original claims 6-7 was added in the canceled original application claims (i.e., claim 1) for the purpose of making the claims (original claims 19 and other claims 2-3, 5, 14-16, 20-21, 23-27) allowable over the rejection (by Jacobs) made in the application.

Therefore, newly added claims 26-33 are also rejected in the same ground as for being broader in scope than the claim of the original application which was canceled from the original application to obtain a patent. *Ball*, 729 F.2d at 1436, 221 USPQ at 295. Even though application made no argument on the record that such limitations was added to obviate the rejection, the nature of the addition to the claim was shown that such limitations was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. Thus, such omission of such limitations set forth above is related to subject matter surrendered in the original application. Since the applicant had narrowed the claims for the purpose of obtaining allowance in the original prosecution, and applicant is now precluded from recapturing subject matter previously surrendered. See also *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

It is further noted that newly added claims 26-33 are directed to independent and distinct inventions. Since these claims have never been introduced or claimed in the original patent, no restriction on different invention or species is required and these claims are treated by a rejection such as not being for the invention disclosed in the original patent as previously set forth above, as evidenced by the claims in the original patent (*In re Rowand*, 526 F. 2d 558, 187 USPQ 487 (CCPA 1975)) or not being for matter which might have been claimed in the original patent, or on the ground which may be lack of defect in the original patent and lack of error in obtaining the original patent as previously set forth above.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 29-32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the amendment received on March 16, 2001, claim 14 is vague as for the reason that the phrase "A compact smoking oven, comprising a box-shaped housing having a peripheral wall composed of two wall portions spaced from one another and A compact smoking oven, comprising a [box-shaped] housing..." recited at lines 1-4 was redone and does not make any sense. Therefore, the part of the phrase "A compact....another and" recited at lines 1-3 must be deleted.

In claim 29, there is insufficient antecedent basis for "the axial direction" recited at line 10 (the March 16, 2001 amendment). Such "axial direction must be clearly defined. The phrase "to allow said rotatable food support to be removable from said

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compact smoking oven" recited at lines 15-16 renders the claim indefinite because it noted that in the preamble of claim 29, the rotatable food support and the compact smoking oven have been claimed in combination so that the compact smoking oven is also a part of the claimed combination or at least a part of the food support itself (see at line 3, after "comprising"), it is unclear how the food support can be removed from "itself". Clarification is needed. It is suggested that the recitation of "a compact smoking oven" (at line 3) should be deleted since such oven have already been recited in the preamble.

Claim 31 (of the March 16, 2001 amendment) is indefinite for not further limit the preceding claim 29 with the recitation "at least two rotatable discs" (recited at line 3). It is unclear how these "two rotatable discs" can be related to the "at least one rotatable disc" recited at line 8 of claim 29. Thus, claim 31 appears to be incomplete for omitting essential structural cooperative relationships between the "two rotatable discs" and the "at least one rotatable disc" recited in claim 29, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

In claim 32, there is insufficient antecedent basis for "the axial direction" recited at line 11 (the March 16, 2001 amendment). Such "axial direction must be clearly defined. The term "rograte" recited at line 13 is misspelled. It must be changed to "grate".

In claim 34, "said food product" recited at line 4-5 (March amendment) lacks antecedent basis from the preceding claim 5.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Riccio (US 5,184,540). Riccio shows a rotatable food support comprising a first and second rotatable discs 88, each has an outer surface, an inner surface, and an axis, a plurality of rods or spits 68 rotatably mounted on first and second discs and spaced apart in a circumferential direction, each rod having an axis, a first end 70, and a second end 72, wherein the axis of the first and second discs are aligned with each other, wherein the ends of each rod are inserted through the corresponding openings in the first and second discs so that the rod is turnably secured within at least one of the discs, wherein discs and rods are configured so as to allow rods to rotate around their axes while discs are rotated, and each of rods further comprises a flywheel or fins 74,76,78.

Claims 29 and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Moreth (US 5,373,778). Moreth shows a rotatable food support 9 (as shown in Figures 10 and 13-14) in combination with a compact smoking oven 1, the food support

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comprising at least one rod 11 or 12 rotatably mounted within the oven for supporting food (see Figures 9-10), two rotatable discs 28 or 67 with at least one disc being detachably connected to the rod 11 (see Figures 10 and 13, i.e., the disc 28 can be removed from the rod by screws 71 in place for grippers 67) so as to move the disc along the rod 11 and to remove food from the rod, the rod 11 is also displaced between the interior wall of the oven and the discs 28 and both the discs and the rod are detachably mounted within the oven to allow the food support to be removable from the oven without disassembly for loading and unloading food.

Claims 29 and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kahn (US 2,348,545). Kahn shows a rotatable food support (as shown in Figures 1-2 and 4) in combination with a compact smoking oven, the food support comprising at least one rod 53 rotatably mounted within the oven for supporting food, two rotatable discs 58 with at least one disc being detachably connected to the rod 53 (see Figure 2, i.e., the disc 28 can be removed from the rod by collars 56 and screws 57) so as to move the disc 28 along the rod 53 and to remove food from the rod, the rod 53 is also displaced between the interior wall of the oven and the discs 58 and both the discs and the rod are detachably mounted within the oven to allow the food support to be removable from the oven without disassembly for loading and unloading food.

Claims 29-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Unruh et al (US 5,421,318) recited in the previous Office Action. Unruh et al shows a rotatable food support 18 (as shown in Figures 2, 4, and 6) in combination with a compact smoking oven 10, the food support comprising at least one rod 88 rotatably mounted within the oven for supporting food, two rotatable discs 94 (shown in Figure 6) with at least one disc being detachably connected to the rod 88 to remove food from the the grate 18 (shown in Figure 4) which is removably attached to the discs for supporting food and being configured to rotate together with the discs, the rod is also displaced between the interior wall of the oven and the discs and both the discs and the rod are detachably mounted within the oven to allow the food support to be removable from the oven without disassembly for loading and unloading food.

Claim 33 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koziol (US 3,566,777). Koziol shows a rotatable food support 10 in a combination with a compact smoking oven (see Figure 1), the food support comprises at least one grate for supporting the food, the grate is rotatably mounted on at least one rod 12 located within the oven, the rod is rotatable about its own axis, the grate is composed of at least two portions 25,26 movable between a position in which the portions are located close to one another to enclose the food therebetween (closing position) and an open position in which the portions are moved apart to load or unload the food.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Dodgen (US 5,431,093) and Turner (US 3,792,654).



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Applicant's arguments with respect to claims filed January 22, 2001 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Hoang whose telephone number is (703) 308-3303.

tbh  
April 18, 2001

  
Tu Ba Hoang  
Primary Examiner